

## Remarks

- 1) Applicant hopes that this response will further the understanding of applicant's invention.
- 2) Claims 73-121 stand rejected. Applicant amended claims 73, 79, 80, 93, and 129, and cancelled without prejudice claims 1-72, 84, 101-106, 111, 113-128 and 132-134, by this or previous amendments.
- 3) The Office rejected claim 73 under 35 U.S.C. §103(a) as being unpatentable over Checco (US 5,859,898) in view of Lovett (US 4,450,477). Applicant amended the claim, substantially rewriting canceled claim 84 in independent form. As the amended claim 73 requires the user input signals to be inputted via a telephone while the message is outputted on a television set. Applicant thereby overcame the rejection as Checco specifically states (Col 10, ll. 22 – Col. 11, ll. 10) that a **calling device 450 issues a request** to the system 304 (Checco col. 10, ll. 26-27), and the user identifies the message or messages to be retrieved. However once a message is selected and translated, the message is **"DELIVERED TO THE CALLING DEVICE 450"**. (Checco col. 10 ll. 58-61) (Emphasis added). This clearly differs from the features claimed in **claim 73 requiring entry of the user input via a telephone and delivery of the message via television**. Thus the Checco patent not only does not disclose the claimed features, but explicitly teaches away therefrom. Therefore, applicant respectfully submits that claim 73, as amended, and its dependent claims, overcomes the teaching of the cited art, and that the claims are allowable.
- 4) Claim 93 and 129 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh 970 (US 5,999,970) in view of Krisbergh 649 (US 5, 138, 649). The inapplicability of the Krisbergh 970 patent was addressed in the response filed June 27, 2003, agreed to by the Office on December 4, 2003, and addressed again in the response filed May 4, 2004. For brevity, applicant will not restate the arguments raised in the earlier correspondence and requests that the arguments

made therein will be considered applicable to the present rejection, as well as the new arguments made herewith.

- 5) Krisbergh 649 is directed to a remote control and a telephone handset which are combined in a single unit (Krisbergh 649, abstract). However the functionality of the telephone and the remote control are clearly separate as can be seen for example in Col. 2, ll. 6-16, and more specifically in col. 4, ll. 59-63 which specifically states: *"In accordance with present invention, a mode switch 32 is provided so that a user can select the telephone mode or the remote control mode of operation of the device"* (Emphasis added). Thus, for the present invention, the Krisbergh 649 patent does not provide any feature different than an ordinary telephone, but for the fact that the telephone and the remote control are contained in a single enclosure. The Office postulated that as Krisbergh 970 describes a remote control to control the access system described therein (as opposed to a messaging system of the present invention) and as Krisbergh 649 described a combination handset and a remote control, it would have been obvious for the one of ordinary skill in the art to combine the references. However, as shown above the combination of the telephone and remote control is one of common components and common enclosure, BUT NOT A COMBINATION OF FUNCTION, as the telephone and the remote control are operated in distinct and separate modes of operation. Krisbergh 649 is silent about the claimed feature of entering message control commands using a telephone. Thus the combination of Krisbergh 970 and Krisbergh 649 fail to disclose all the claim elements, and therefore the rejection is improper.
- 6) Moreover, applicant respectfully directs the Office's attention to the fact that Krisbergh 970 is a newer invention than Krisbergh 649. Undeniably, as common inventors of Krisbergh 970, both Mr. Krisbergh and Mr. Wachob were aware of the Krisbergh 649 invention, which they have both made. Therefore, if as the Office claims, the combination would have been obvious to one with ordinary skill in the art, without the use of the teaching of the present invention, at least

one of the common inventors in Krisbergh would have described the combination for achieving the benefits claimed to be obvious by the Office, or at least hint to the desirability of such combination. However, as the telephone and remote control in Krisbergh 649 are functionally separate entities, and as the Krisbergh 970 does not see the benefit of using a telephone for controlling messages in an access system (as opposed to a messaging system), the Krisbergh 970 does not mention the combination or even desirability for such combination. Therefore it is clear that the combination suggested by the Office would NOT have been obvious to the skilled in the art, that the references lack suggestion and/or motivation to combine in the manner suggested by the Office, or even that the desirability of such combination may have been obvious, without the use of the teaching of the present invention. Therefore applicant respectfully submits that the combination suggested by the Office uses impermissible hindsight, and that the rejection is therefore improper.

- 7) Moreover, the Krisbergh 970 reference to a telephone can be found in col. 14, ll. 26-31, in which Krisbergh's lauds the advantages of the system as enjoying a higher bandwidth than the one offered by using a telephone, and furthermore the advantage of the user avoiding the need to tie up a telephone line to obtain information. Clearly, when considered as a whole, Krisbergh 970 teaches away from the present invention as claimed in claims 93 and 129, which requires the use of a telephone line (The manner in which the telephone line is implemented, e.g. common carrier, cellular, VOIP, cable television and the like, is immaterial). Therefore the proposed combination of Krisbergh 970 and Krisbergh 649 are impermissible (see *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, (Fed. Cir. 1983)).
- 8) Furthermore, the proposed modification would have clearly render the Krisbergh 970 patent unsatisfactory for its intended purpose as it would clearly destroy the stated and intended advantage of not having to tie up the telephone line. *"If proposed modification would render the prior art invention being modified"*

*unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification" in re Gordon, 733 F.2d 900 (Fed. Cir. 1984).*

- 9) For all the reason stated above applicant respectfully submits that the combination of Krisbergh 970 and Krisbergh 649 is impermissible, and that the rejection of claims 93 and 129 and their dependent claims where improper, and respectfully requests that the rejection be reconsidered and withdrawn.
- 10) Claim 107 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Checco in view of Lovett. The Office cited Checco col. 10, ll. 21-48. Applicant respectfully submits that this citation should be extended to further read on col. 10 to line 61, where Checco specifically states that the message is sent to the calling device 450, which is identical to the calling device 450 that issued the request for the message. Therefore, the references, alone or in combination, fail to disclose the claimed features of inputting commands to a television messaging gateway using a telephone, and causing the television messaging gateway to output the message on a television set. Therefore, applicant respectfully submits that the rejection of claim 107 and its dependent claim is improper as the references, taken alone or in combination, do not teach all the claim limitations.
- 11) Applicant has made a good faith effort to address each and every point made by the Examiner, and amended the claim in order to place the application in condition for allowance. Should the Examiner find any deficiency in this amendment or in the application, or should the Examiner believe for any reason, that a conversation with applicant's agent may further the allowance and issuance of this application, the Examiner is kindly requested to contact Shalom Wertsberger at telephone (207) 799-9733.
- 12) In light of the showing and all other reasons stated above, applicant believes that the rejections presented by the Examiner in the office action mailed to applicant on Dec. 29, and the advisory action mailed to applicant May 6, 2005 were

overcome. Applicant therefore submits that the claims as amended are in condition for allowance. Reconsideration and withdrawal of the rejection and issue of a notice of allowance on all pending claims is respectfully solicited.

Respectfully submitted



Shalom Wertsberger

Reg. Num 43,359

30 Fern Lane

South Portland, ME

04106

Phone: (207) 799-9733

Fax: (207) 767-5324

Agent for Applicant